Office Action Summary	Application No. 09/612,286	Applicant(s) ABUSLEME ET AL.	
	Examiner Callie E. Shosho	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 September 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3 and 7-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3 and 7-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/3/02 has been entered.

2. Applicants' amendment filed 7/30/02, Paper No. 10, which was previously not entered, has now been entered. All outstanding rejections except for those described below are overcome by this amendment.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) The scope of claim 3 is confusing given that the claim depends on cancelled claim 2. Should the dependency of claim 3 be changed to claim 1?

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(a) The scope of claim 3 is confusing given that the claim depends on cancelled claim 2. Should the dependency of claim 3 be changed to claim 1?

(b) Claim 8 recites the limitation "the reaction medium" in line 1. There is insufficient antecedent basis for this limitation in the claim given that there is no disclosure in claim 1, on which claim 8 depends, of reaction medium.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3, 7, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Abusleme et al. (U.S. 5,498,680).

Abusleme et al. disclose a process of synthesizing chlorotrifluoroethylene homopolymer or copolymer with additional fluorinated monomers including perfluorinated monomers wherein the process is conducted in perfluoropolyoxyalkylene microemulsion which comprises perfluoropolyoxyalkylene surfactant identical to those presently claimed in the presence of alkali metal persulfate initiator. The process is conducted at temperature of 10^0-150^0 C and 15-40 bar (col.1, lines 19-27, col.4, lines 5-21 and 63-64, col.5, lines 18-41, 47-48, 51-52, and 55-56, and col.6, lines 17-21).

In light of the above, it is clear that Abusleme et al. anticipates the present claims.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abusleme et al. (U.S.5,498,680) in view of Campbell et al. (U.S. 4,577,044).

The disclosure with respect to Abusleme et al. in paragraph 6 above is incorporated here by reference.

The difference between Abusleme et al. and the present claimed invention is the requirement in the claims of liquid chlorotrifluoroethylene.

Campbell et al., which is drawn to process of preparing chlorotrifluoroethylene telomers, disclose the use of liquid chlorotrifluoroethylene in the reaction medium which allows for the use of lower process temperatures (col.2, lines 14-23 and 35-45).

In light of the motivation for using liquid chlorotrifluoroethylene disclosed by Campbell et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use liquid chlorotrifluoroethylene in the process of Absuleme et al. in order to control the process temperature, and thereby arrive at the claimed invention.

Response to Arguments

10. The above action is based on the amendment filed 7/30/02 which was previously not entered. In the advisory mailed 8/14/02, examiner stated that even if the amendment were to be entered, the rejections of record with respect to Absuleme et al. (U.S. 5,498,680) would not be overcome.

Given that this amendment has now been entered, examiner re-states applicants' arguments set forth in the amendment filed 7/30/02 as well as examiner's response to these arguments.

Applicants argue that Absuleme et al. is not a relevant reference against the present claims given that there is no disclosure in Absuleme et al. of combination of specific fluorinated

surfactant and initiator as presently claimed. Applicants argue that Absuleme et al. disclose that the initiator is indifferently selected from list of initiators while fluorinated surfactant is indifferently selected from list of surfactants.

However, it is noted that "when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named", *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). Further, it is noted that the choice of each of the claimed initiator and surfactant is not made from a long list. Thus, given that Absuleme et al. disclose process of synthesizing chlorotrifluoroethylene homopolymer or copolymer wherein the process is conducted in perfluoropolyoxyalkylene microemulsion which comprises perfluoropolyoxyalkylene surfactant identical to those presently claimed in the presence of alkali metal persulfate initiator, it is clear that Absuleme et al. meets the limitations of the present claims.

It is noted that Abusleme et al. disclose the use of initiators which include alkali metal persulfates and ammonium persulfates. The comparative data in the present specification compares invention within the scope of the present claims, i.e. utilizing potassium persulfate (example 1), with invention outside the scope of the present claims, i.e. comprising ammonium persulfate (example 5). It is shown that the process of the present invention produces chlorotrifluoroethylene polymer with no discoloration while the comparative process produces a chlorotrifluoroethylene polymer which is discolored.

However, it is noted that the present claims are not rejected as being obvious over the cited art, but rather are anticipated over the prior art. Given that Abusleme et al. already disclose

the use of initiator as presently claimed, the results of the comparison in the declaration are not believed to be unexpected or surprising.

Additionally, as cited in MPEP 706.02(b), it is noted that a rejection based on 35 USC 102(b), such as Abusleme et al., can only be overcome by (a) persuasively arguing that the claims are patentably distinguishable from the prior art, (b) amending the claims to patentably distinguish over the prior art, or (c) perfecting priority under 35 USC 119(e) or 120. As can be seen, comparative data is not sufficient to overcome an anticipatory rejection under 102(b).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Callie E. Shosho
Examiner
Art Unit 1714

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November 1, 2002